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Docket Number (Optional)

RD-28615 (07783-0073-01)

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on July 26, 2005

Signature

Typed or printed name Kimberly A. Newell

Application Number

09/917,435

Filed

July 27, 2001

First Named Inventor

GORMAN, et al.

Art Unit

2178

Examiner

Jonathan D. Schlaifer

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)☒

attorney or agent of record.

Registration number 50,311

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attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

  
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July 26, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.☒

\*Total of 1 forms are submitted.

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Attorney Docket No. RD-28615 (07783-0073)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re U.S. Patent Application of:

William Phillip GORMAN, et al.

Patent Application No.: 09/917,435

Filed: July 27, 2001

Title: WEB PAGE AUTHORIZING TOOL

Group Art Unit: 2178

Examiner: Jonathan D. Schlaifer

Confirmation No.: 9715

**MAILSTOP AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

This Pre-Appeal Brief Request for Review is filed in response to a Final Office Action dated May 5, 2005 in the above-captioned application (the "Application") in accordance with the procedures announced in the Official Gazette on July 12, 2005. A Notice of Appeal is filed concurrently herewith.

**CONSIDER STATEMENT OF ISSUES TO ACCOMPANY THE  
PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**I. REJECTION UNDER 35 U.S.C. §102(b)**

Claims 1-2, 7-11, 14-16 and 18-20 remain rejected by Towers.

**A. The Examiner has not presented an enabling reference in Towers**

As discussed in more detail at pages 12-13 of the Response filed by Applicants on January 3, 2005 (the 1/3/05 Response), the rejection by the Examiner is clearly erroneous because the few pages of Towers provided to Applicants are insufficient to make Towers an enabling reference and do not contain enough information to make and use the invention that the Examiner asserts has been disclosed.

Specifically, Towers is a reference guide that is at least 355 pages long, but only 15 non-consecutive pages – 2 of which are non-substantive and include the cover and inside cover – were provided to Applicants. Those few pages that were provided are incomplete to show Applicants' invention as recited in the independent claims. It is noted that "[t]he identical invention must be shown in as complete detail as shown in the claims." *See* MPEP 2131.

While the Examiner has offered at page 8 of the Final Office Action to provide additional pages from Towers as to places where Applicants "have a specific...issue where the excerpt of Towers was insufficient," this offer was made while simultaneously making the rejection Final, leaving Applicants without an opportunity to properly respond. Further, Applicants had already raised specific points where Towers was incomplete and non-enabling in the 1/3/05 Response but the Examiner did not include any additional pages with the Final Office Action. Finally, as Applicants do not have a copy of the Towers reference, Applicants have no way of knowing what sections or pages of Towers are relevant to the issues at hand. Thus, the Examiner's

attempts to shift the burden to Applicants for requesting additional information appears to be improper.

**B. Even if Towers was enabling, it still fails to anticipate the claimed invention.**

Applicants incorporate the arguments found at pages 13-16 of the 1/3/05 Response.

Each of independent claims 1, 9 and 16, and thus all claims depending therefrom, includes the limitation that program code is generated as a single file for execution by the web browser. The Examiner restates in the Final Office Action (page 9) that because Towers can be saved as an “html” file, it meets the single file for execution limitation. Towers does not teach, disclose or suggest that the saved html file is a single file created for execution by a web browser as used with respect to Applicants’ claimed invention, i.e. one that generates both a visual appearance and a dynamic behavior of certain fields, e.g. without plug-ins, modifications or additions. It appears that the Examiner has completely disregarded the remaining language of the limitation, i.e., “to implement the visual appearance and dynamic behavior of the selected fields inserted into the visual development environment.” In making the rejection, the Examiner has cited nothing in Towers addressing this language in the claim and has only identified that Towers teaches an “html” file.

In claims 1 and 16, Applicants’ claimed invention requires customizing the dynamic behavior of a field using at least one additional visual editor of the visual development environment. As understood by Applicants, the Examiner appears to state in the Final Office Action at page 9 that merely because it takes time for one to use the Dreamweaver program to modify behavior of otherwise static fields, that the reference necessarily includes customizing the dynamic behavior of a field. The Examiner provides no basis or teaching of Towers that

supports this clearly erroneous assertion. It further appears that the Examiner has confused the dynamic behavior of the inserted field, when executed, with the generation of the field over time.

Next, the Examiner merely asserts that because a Towers can be used to arrive at a finished product, it necessarily evidences a repetition of certain steps of Applicants' claimed invention. However, the Examiner has failed to show that Towers contains various steps of Applicants' claimed invention, much less that those steps are repeated.

With respect to claim 9, at most Towers only teaches a remote site to which one can connect to an existing web site. There is no teaching in Towers that a server provides access to generated program code by the authoring tool for a web application to an end-user having a web browser. That is, as understood by Applicants, Towers fails to teach that the remote site, for example, provides access to generated program code as found in Applicants' claimed invention, or that it communicates with the authoring tool.

**CONCLUSION**

The Examiner has committed clear error in citing Towers, which is not an enabling reference, at least as provided to Applicants. The Examiner has further failed to present a prima facie case of anticipation. Even if Towers were an enabling reference, it fails to teach each and every limitation of the claimed invention as required for anticipation.

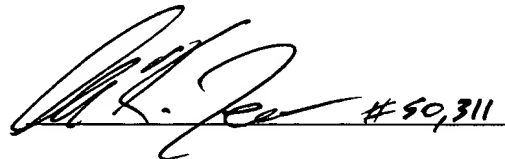
Applicants respectfully request that the Panel withdraw all outstanding rejections and allow the Application.

Date: July 26, 2005

Respectfully submitted,

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By:



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